

REMARKS

This paper is responsive to an Office Action mailed January 10, 2008. Prior to this response, claims 1-6, 8-17, and 19-31 were pending. After amending claims 1-6, 8-13, 15-17, 19-31, and canceling claim 14, claims 1-6, 8-13, 15-17, and 19-31 remain pending.

In Section 6 of the Office Action claim 23 has been objected to under 37 CFR 1.75(a). In response, the claim has been amended to recite first and second parts of the scan job.

In Section 8 of the Office Action, claims 15, 19, 23-24, and 30 have been rejected under 35 U.S.C. 102(b) as anticipated by Kono et al. ("Kono"; Japan 11-275291). The Office Action states that Kono discloses a scanning device that partially processes a scan job and an interface that partially processes the scan job. This rejection is traversed as follows.

In paragraphs [0035-0040] Kono describes a process where a client device makes a first request to a central server to scan data (acquisition) from the scanner. After the server captures the image, the client makes a second request instructing the server to name the file or print the file. Once these two independent processes are completed, the server data-processing means sends the scanning-and-processing result to the client.

To clarify the differences between the claimed invention and Kono, claims 1, 15, and 30-31 has been amended to recite a system that submits a single (first) scan. In contrast, Kono serially submits two separate scan jobs. That is, Kono's process creates one set of scan task

commands for a first scan job (e.g., capture data) and different set of commands for the second scan job (e.g., name or print file). In claim 15, since all the instructions are in the single scan job, the partial processing of the job can be conducted on a peer-to-peer basis. That is, neither a central node nor client are needed to determine which parts of the scan job will be performed by which node. In contrast, Kono describes a process that is controlled through central server node, in response to instructions from a client. Since all the instructions are in the Applicant's single scan job, a partially performed job can be sent from a first node, partially processed at a second node, and returned to the first node for completion without the need to communicate with a central server or client device. In contrast, Kono sends a first scan job to a first node for completion. The central server must wait to the first scan job to be completed before it can send the completed scan job (i.e., a second scan job) to a second node for processing.

Thus, Kono does not disclose the claim limitations of partially performing different aspects of the *same* scan job (the first scan job) at two different nodes, as recited in claim 15. As noted above, Kono's process involves two separate requests. Since Kono does not disclose every limitation of claim 15, he cannot anticipate the claim. Claims 19, 23-24, and 30, dependent from claim 15, enjoy the same distinctions with respect to Kono.

In Section 10 of the Office Action, claims 11, 16, 31 have been rejected under 35 U.S.C. 103(a) with respect to Kono. The Office Action states that Kono fails to disclose the deletion of SDL commands after the completion of each task. The Office Action takes Official Notice that scan

subsystems delete SDL commands after a task is completed, making the claimed limitations obvious. This rejection is traversed as follows.

At noted in response to the anticipation rejection (Section 8 of the Office Action), Kono fails to disclose the claim limitations of partially performing different aspects of the same scan job at two different nodes, as recited in claim 15. Therefore, even if it would have been obvious to delete SDL commands, Kono fails to explicitly disclose or suggest modifications that would make obvious the partial performance of different aspects of the same scan job at two different nodes, as recited in independent claims 1, 15, and 31. Claim 11, dependent from claim 1, and claim 26, dependent from claim 15, enjoy the same advantages.

In Section 11 of the Office Action claims 16-17 and 20 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kono in view of Aiyama (Japan 2003-244377) and Maniwa (US 5,764,866). With respect to claim 16, the Office Action acknowledges that Kono fails to disclose a scanning device or web page second node, but that these features are disclosed in Aiyama and Maniwa. The Office Action states that it would have been obvious to modify Kono to easily facilitate remotely actuating a scan operation (Aiyama) and to set scan conditions on site (Maniwa). This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Kono would have been obvious to one of ordinary skill in the art in light of Aiyama and Maniwa. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Aiyama and Maniwa references has been combined with Kono based upon the assumption that Kono discloses every limitation recited in Applicant's claim 15. As noted above however, Kono fails to disclose the claim limitations of partially performing different aspects of the same scan job at two different nodes. Therefore, even if Aiyama's web page and Maniwa's front panel are combined with Kono, that combination does not explicitly disclose every limitation of claim 15. Claims 16-17 and 20, dependent from claim 15, enjoy the same advantages.

The Office Action states that it would have been obvious to apply the features of Aiyama and Maniwa to Kono because it would facilitate remotely actuating of a scan operation or permit scan conditions to be set on site. However, the motivation to actuate a scanner either on-site or remotely does not suggest the claim limitations of partially performing different aspects of the same scan job at two different nodes, as recited in claim 15. A *prima facie* analysis of motivation is especially

critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Kono reference. However, there is nothing in the Kono reference that suggests that multiple, serially-processed scan jobs can be submitted as a single scan for processing at multiple nodes.

Neither does the obviousness rejection provide evidence that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. “(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to partially performing different aspects of the same scan job at two different nodes.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if an expert were given the Kono, Aiyama, and Maniwa references as a foundation, no evidence has

been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Kono, Aiyama, and Maniwa does not explicitly disclose every limitation of claim 15. Neither has a case been supported that Kono can be modified to supply the missing limitations in view of Aiyama and Maniwa, or what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 16-17 and 20 be removed.

In Section 12 of the Office Action claim 21 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kono, Aiyama, and Maniwa, in view of Sakai et al. ("Sakai"; US 6,804,414), Venable (US 6,738,154, Sylthe (US 2002/0161796), and Suzuki (US 6,930,803). The Office Action states that the combination of Kono, Aiyama, and Maniwa fails to disclose recited image manipulations options, but that the omitted features are disclosed in the above-mentioned references. The Office Action states that it would have been obvious to combine references to include the omitted image manipulation options. This rejection is traversed as follows.

The obviousness rejection is based upon the assumption that Kono discloses all the limitations of the base claim 15. However, as noted above, Kono fails to disclose the claim limitations of partially performing

different aspects of the same scan job at two different nodes. Even if Aiyama's web page, Maniwa's front panel, and the image manipulations of Sakai, Venable, Sylthe, and Suzuki are added to Kono, the combinations still fails to describe the claim limitations of partially performing different aspects of the same scan job at two different nodes.

Further, the motivation of incorporating image manipulation options does not suggest modifications to Kono that would make all the limitations of claim 15 obvious, based on either the Aiyama/Maniwa/Sakai/Venable/Sylthe/Suzuki references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Kono that would make all the limitations obvious, the Applicant requests that the rejection of claim 21, dependent from claim 15, be withdrawn.

In Section 13 of the Office Action claim 22 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kono, Aiyama, and Maniwa, in view of Yamauchi et al. ("Yamauchi"; US 5,701,497) and Sylthe. The Office Action states that the combination of Kono, Aiyama, and Maniwa fail to disclose a user interface for segmentation options, but that this limitation is recited in Yamauchi and Sylthe and that it would have been obvious to combine references to translate documents into the native language of the recipient and to improve image quality. This rejection is traversed as follows.

The obviousness rejection is based upon the assumption that Kono discloses all the limitations of the base claim 15. However, as noted above, Kono fails to disclose the claim limitations of partially performing different aspects of the same scan job at two different nodes. Even if

Aiyama's web page, Maniwa's front panel, and the user interfaces of Yamauchi and Sylthe are added to Kono, the combinations still fails to describe the claim limitations of partially performing different aspects of the same scan job at two different nodes.

Further, the motivation of translating documents into the native language of the recipient or improving image quality does not suggest modifications to Kono that would make all the limitations of claim 15 obvious, based on either the Aiyama/Maniwa/Yamauchi/Sylthe references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Kono that would make all the limitations obvious, the Applicant requests that the rejection of claim 22, dependent from claim 15, be withdrawn.

In Section 14 of the Office Action claims 1, 8-9, and 14 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kono, Maniwa, Yamauchi, and Sylthe. The Office Action states the rationale for the rejection of claim 1 is the same as for the rejection of claim 22. Thus, it is acknowledged that Kono and Maniwa fail to disclose a user interface for segmentation options, but that this limitation is recited in Yamauchi and Sylthe and that it would have been obvious to combine references to translate documents into the native language of the recipient and to improve image quality. This rejection is traversed as follows.

The obviousness rejection is based upon the assumption that the combination of references discloses all the limitations of the base claim 1. However, as noted above, Kono fails to disclose the claim

limitations of partially performing different aspects of the same scan job at two different nodes. Even if Maniwa's front panel, and the user interfaces of Yamauchi and Sylthe are added to Kono, the combinations still fails to describe the claim limitations of partially performing different aspects of the same scan job at two different nodes, as recited in claim 1.

Further, the motivation of translating documents into the native language of the recipient or improving image quality does not suggest modifications to Kono that would make all the limitations of claim 1 obvious, based on either the Maniwa/Yamauchi/Sylthe references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Kono that would make all the limitations obvious, the Applicant requests that the rejection of claims 1 and 8-9 be withdrawn.

In Section 15 of the Office Action claims 2-3 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kono, Aiyama, and Maniwa, in view of Yamauchi and Sylthe. The Office Action states that Kono fails to disclose a second node web page or front, but that these features are disclosed by Aiyama and Maniwa. The Office Action states that it would have been obvious to modify Kono to easily facilitate remotely actuating a scan operation (Aiyama) and to set scan conditions on site (Maniwa). This rejection is traversed as follows.

The obviousness rejection is based upon the assumption that combination of references discloses all the limitations of the base claim 1. However, as noted above, none of Kono, Aiyama, Maniwa, Yamauchi, or Sylthe disclose the claim limitations of partially performing different aspects of the same scan job at two different nodes. Even if Aiyama's web

page, Maniwa's front panel, and the user interfaces of Yamauchi and Sylthe are added to Kono, the combinations still fails to describe the claim limitations of partially performing different aspects of the same scan job at two different nodes.

Further, the motivation of actuating a scan process either remotely or on-site does not suggest modifications to Kono that would make all the limitations of claim 1 obvious, based on either the Aiyama/Maniwa/Yamauchi/Sylthe references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Kono that would make all the limitations obvious, the Applicant requests that the rejection of claims 2-3, dependent from claim 1, be withdrawn.

In Section 16 of the Office Action claim 6 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kono, Aiyama, and Maniwa, in view of Sakai, Venable, Sylthe, Suzuki, and Yamauchi. The Office Action states that the combination of Kono, Aiyama, and Maniwa fail to disclose recited image manipulations options, but that the omitted features are disclosed in the above-mentioned references. The Office Action states that it would have been obvious to combine references to include the omitted image manipulation options. This rejection is traversed as follows.

The obviousness rejection is based upon the assumption that the combination of references fails to disclose all the limitations of the base claim 1. None of the references discloses the claim limitations of partially performing different aspects of the same scan job at two different nodes. Even if Aiyama's web page, Maniwa's front panel, and the image

manipulations of Sakai, Venable, Sylthe, Suzuki, and Yamauchi are added to Kono, the combinations still fails to describe the claim limitations of partially performing different aspects of the same scan job at two different nodes, as recited in claim 1.


Further, the motivation of incorporating image manipulation options does not suggest modifications to Kono that would make all the limitations of claim 1 obvious, based on either the Aiyama/Maniwa/Sakai/Venable/Sylthe/Suzuki/Yamauchi references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Kono that would make all the limitations obvious, the Applicant requests that the rejection of claim 6, dependent from claim 1, be withdrawn.

Section 17 of the Office Action states that claims 10 and 25 would be found allowable if rewritten in independent form, including all the subject matter of the base and intervening claims.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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Respectfully submitted,



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